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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,603	12/11/2001	Oswald Gasser	0475-0198P	4201
2292	7590	08/23/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			LEWIS, RALPH A	
			ART UNIT	PAPER NUMBER
			3732	
DATE MAILED: 08/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/009,603

Applicant(s)

GASSER ET AL.

Examiner

Ralph A. Lewis

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24-30 is/are allowed.
- 6) ☒ Claim(s) 17, 19-22, 39, 40, 44 and 45 is/are rejected.
- 7) ☒ Claim(s) 18, 23, 31-38, 41-43 and 46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 08032005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **Withdrawal of Allowable Subject Matter**

The indicated allowability of claims 17-46 in the Office Action of April 07, 2005 is withdrawn in view of the following new grounds of rejection, based on newly cited prior art. Additionally, the Finality of the Office Action of April 07, 2005 is withdrawn in view of the new grounds of rejection.

### **Rejections based on Prior Art**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17, 19, 39, 44 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Kokal, Jr. (US 3,959,881).

Kokal, Jr. discloses a composition comprised of a deformable film 12 14 support material and diagnostically useful additive 16. The additive 16 is comprised of microencapsulated ink or dye that is used to diagnose contact points between the upper and lower teeth. The microcapsules rupture in response to biting pressure which gives the specific location (i.e. "locus-specific") and substance of the contact by indicating points of greater and lesser biting pressure (i.e. "substance specific")(see column 3, line

9-10). The ruptured ink capsules mark the surface of the support material thereby providing a signal (i.e. "signal development").

In regard to claim 45, at least during use, some of the microcapsules are intact and at least some are burst releasing the diagnostically useful substance.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20-22, 40 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kokal, Jr. (US 3,959,881).

In regard to claims 20 and 21, the specific range of the amount of diagnostic material added includes values that one of ordinary skill in the art would have found obvious in constructing the Kokal, Jr. device. In regard to claim 22, Kokal Jr. discloses the support material to be of "paper," however, the ordinarily skilled artisan would have found the use of conventional plastic in place thereof to have been an obvious substitution of well known prior art materials. In regard to claim 40, the selection of common dyes for the dyes/inks of Kokal Jr. would have been obvious to the ordinarily skilled artisan. In regard to claim 46, taking a picture of the Kokal Jr. detecting

composition after it has been used so as to maintain a record of the bite for the patient's bite would have been obvious to one of ordinary skill in the art as a matter of routine dental office practice.

### **Prior Art**

Applicant's information disclosure statement of August 03, 2005 has been considered and an initialed copy enclosed herewith.

Komura et al (US 4,397,944), Frysh (US 4,666,700), Skaggs et al (US 4,992,256), Simone et al (US 5,190,743), Komatsu et al (US 5,395,239) and Fukunishi et al (US 6,084,005) are made of record.

### **Allowable Subject Matter**

Claims 18, 23, 31-38, 41-43 and 46 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form to include all of the limitations of the claims from which they depend.

Claims 24-30 are allowed.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.


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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (571) 272-4720.

R.Lewis  
August 10, 2005

  
**Ralph A. Lewis**  
Primary Examiner  
Au3732